

REMARKS

Summary of the Office Action

The title of the invention is allegedly not descriptive. A new title is required.

The Examiner reminds Applicants of the proper language and format for the abstract of the disclosure.

Claims 7-9 stand rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter.

Claims 1-10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ueda et al. (U.S. Publication No. 2001/0005442) (hereinafter "Ueda").

Summary of the Response to the Office Action

Applicants have amended the title and abstract to improve their form. Applicants have amended claims 1, 4, and 7-9 to differently describe embodiments of the disclosure of the instant application's specification. Accordingly, claims 1-10 remain pending for consideration.

Objection to the Title

The Office Action alleges that the title of the invention is "not descriptive." Accordingly, a new title is required. In accordance with this requirement, Applicants have replaced the previous title with a more descriptive title. Withdrawal of the requirement for a new title is thus respectfully requested.

Objection to the Abstract

The Examiner reminds Applicants of the proper language and format for the abstract of the disclosure. For example, the Examiner notes that the abstract of the disclosure must not include more than 150 words and must be contained in a single paragraph. In response, Applicants have amended the abstract to resolve these issues by providing only one paragraph and deleting portions of the original abstract so that the new abstract includes less than 150 words. Accordingly, Applicants respectfully request that the objection to the abstract be withdrawn.

Rejection under 35 U.S.C. § 102(e)

Claims 1-10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ueda. Applicants have amended claims 1, 4 and 7-9 to differently describe embodiments of the disclosure of the instant application's specification. To the extent that these rejections might be deemed to apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

Independent claim 1 of the instant application has been newly-amended to describe in more detail what is the "flag" and how "the flag" works. Even further, independent claim 1 has been newly-amended to describe in more detail how "the controlling device" works. In addition, the relationship of the flag with "the recording device (process)" is more particularly described in newly-amended independent claim 1.

Applicants respectfully submit that the "flag" described in newly-amended independent claim 1 of the instant application, for example, is the thumbnail image specifier effective flag

(VLD) as described in the specification of the instant application. Also, Applicants respectfully submit that the “controlling device (or determination process)” is a functional device achieved by the CPU 8 in the specification.

In embodiments of the disclosure of the instant application, “the logical recording format comprises a flag that indicates whether an image included in the recorded information or an image not included in the recorded information should be used as a thumbnail.” See, for example, page 23, line 23 – page 24, line 5 (concerning the thumbnail image specifier effective flag VLD); and page 38, line 23 – page 39, line 18 of the instant application’s specification.

Also, Applicants respectfully submit that features of a controlling device being adapted to determine whether the image selected by the first selecting device or the image selected by the second selecting device should be specified as the thumbnail image and the flag being set by the recording device (process) in accordance with the determination of the determination device (process) have been added to newly-amended claim 1 (as well as newly-amended independent claims 4 and 7).

As a result, Applicants respectfully submit that the advantages described in the specification are obtained. See, for example, page 3, lines 15-27 of the instant application’s specification. For example, Applicants respectfully submit that the thumbnail image can be arbitrarily specified. As a result, a user can clearly recognize the contents of the recorded information recorded on the recording medium during reproduction of images to be carried out as one aspect of editing work.

However, Applicants respectfully submit that Ueda fails to teach or suggest, to any extent, the use of the combination of the flag (VLD), the controlling device (or determination

process), and the recording device (process) as specifically described in the advantageous combinations of features of newly-amended independent claim 1 (and newly-amended independent claims 4 and 7).

Applicants respectfully submit that Ueda provides a scheme to determine a moving image (motion picture) that corresponds to a still image, in which the paragraph [0050] thereof shows only recording information indicative of, on a recording medium, a position of a moving picture corresponding to the still image. In Ueda, however, Applicants respectfully submit that there is no disclosure teaching or suggestions the above-discussed advantageous combinations of the newly-amended independent claims of the instant application.

Independent claims 4 and 7 have been amended to include similar features as discussed above with regard to newly-amended independent claim 1 of the instant application. Accordingly, similar arguments as discussed above with regard to newly-amended independent claim 1 of the instant application also apply to newly-amended independent claims 4 and 7.

Accordingly, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(e) should be withdrawn because Ueda does not teach or suggest each feature of independent claims 1, 4 and 7, as amended. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Furthermore, Applicants respectfully assert that dependent claims 2, 3, 5, 6, 8, 9 and 10 are allowable at least because of their dependence from independent claim 1, 4 or 7, as amended, and the reasons set forth above.

Therefore Applicants firmly believe that claims 1-10 of the present application meet the requirements of patentability, and it is respectfully submitted that all the claims now pending are in condition for allowance.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

~~DRINKER BIDDLE & REATH LLP~~

By:



Paul A. Fournier
Reg. No. 41,023

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Customer No. 055694
DRINKER BIDDLE & REATH LLP
1500 K Street, N.W., Suite 1100
Washington, DC 20005-1209
Tel.: (202) 842-8800
Fax: (202) 842-8465